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Docket No.: GB920010099US1 (7161-186U)

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Joshua AUERBACH, et al.	:	Confirmation Number: 5443
	:	
Application No.: 10/017,728	:	Group Art Unit: 2142
	:	
Filed: December 14, 2001	:	Examiner: D. Blair
	:	
For: MESSAGE FILTERING	:	

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed July 28, 2008, wherein Appellants appeal from the Examiner's rejection of claims 8-14.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on February 27, 2002, at Reel 012661, Frame 0103.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 8-14 are pending and seven-times rejected in this Application. Claims 1-7 and 15 have been cancelled. It is from the multiple rejections of claims 8-14 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Seventh Office Action dated April 30, 2008 (hereinafter the Seventh Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figures 1, 3, 4a, and 5a and also to independent claim 8, a method for receiving publications and forwarding the publications on to parties who have subscribed to receive such publications is disclosed. In step 200, a subscription request of a first filter expression format type is received (page 4, line 23 through page 6, line 12; page 16, lines 23-24; of Appellants' disclosure), and the request includes a filter expression having at least one attribute (page 17, lines 1-9). In step 220, at least part of the at least one attribute is mapped to a generic format (page 17, lines 9-10). In step 300, a publication message of a second filter expression format type is received (page 18, lines 18-20). In step 350, the received publication message is compared to the subscription request to determine whether to forward the publication message to a subscriber originating the request (page 19, lines 13-16 and page 20, lines 2-5). In steps 240/320, a generic format filter attribute is identified (page 18, lines 5-7, lines 22-23). In steps 250/330, the generic format filter attribute is mapped to a format corresponding to the second filter expression format type (page 19, lines 10-13). The publication messages is transmitted to the originating subscriber (page 7, lines 4-5). The first filter expression format

type is different than the second filter expression format type (page 5, line 23 through page 6, line 12; page 7, line 23 through page 8, line 11; page 17, lines 19-21; page 18, lines 2-3 and 10-20).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 8-9 and 11-14 were rejected under 35 U.S.C. § 102 for anticipation based upon Herz, U.S. Patent No. 6,460,036; and
2. Claims 8-14 were rejected under 35 U.S.C. § 102 for anticipation based upon Jannu et al., U.S. Patent No. 7,216,181 (hereinafter Jannu).

VII. ARGUMENT

Although Appellants recognize that a claim objection is not subject to review by the Honorable Board, Appellants wish to briefly address the objection to the specification made by the Examiner in the paragraph spanning pages 6 and 7 of the Seventh Office Action. Claims 10 and 14, which are being objected to by the Examiner, are originally filed claims, and original claims constitute their own description.¹ The Examiner has not rejected the claims under the second paragraph of 35 U.S.C. § 112, and thus the Examiner believes the claims to be definite. As such, the Examiner's objection to the specification/claims is unfounded.

The Examiner appears to be hung up on the phrase "substantially empty," yet the use of this phrase is found in issued U.S. Patents. For example, U.S. Patent No. 7,414,460 refers to "the first buffer as being substantially empty" in claim 1. In fact, as of the filing of this Appeal Brief, 376 U.S. patents have issued with at least one claim including the phrase "substantially empty." In the second full paragraph on page 6 of the Response, Appellants also set forth a definition for the term "substantially empty message."

Regarding the claimed "temporary storage," Appellants noted in footnote 1 in the Response to Notice of Non-Responsive Amendment that the phrase "temporary storage" + "computer" yields over 350,000 hits on google.com and 12,113 hits of issued U.S. patents. As such, for the Examiner to object to this claim is akin to objecting to a claim because the phrase "bicycle" or "radio" was not described in the specification. There is no requirement that each

¹ In re Koller, 613 F.2d 819, 204 USPQ 702 (CCPA 1980).

and every term in a claim be described and/or defined in the specification, particularly when those phrases are self-defining and known to those skilled in the art.

**THE REJECTION OF CLAIMS 8-9 AND 11-14 UNDER 35 U.S.C. § 102 FOR ANTICIPATION
BASED UPON HERZ**

For convenience of the Honorable Board in addressing the rejections, claim 9 stands or falls together with independent claim 8, and claims 11-14 each stand or fall alone.

As is evident from Appellants' previously-presented comments during prosecution of the present Application and from Appellants' comments below, there are questions as to how the limitations in the claims correspond to features in the applied prior art. In this regard, reference is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer." Specifically, the following is stated:

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

...

(9)(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner must compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison must align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate. (emphasis added)

Therefore, if the Examiner is to maintain the present rejections and intends to file an Examiner's Answer, the Examiner is required to include the aforementioned section in the Examiner's Answer.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.² Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.³

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art."⁴ During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification,"⁵ and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.⁶ Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these individual elements,⁷ and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual

² In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

³ See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

⁴ Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

⁵ In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

⁶ In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

⁷ See also Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

elements of the claims.⁸ This burden has not been met. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).⁹

Prior to addressing the specifics of the Examiner's rejection, Appellants wish to address certain themes that have been consistently present throughout the extensive prosecution of the present application. The Examiner's analysis appears to be conclusion-based in that the Examiner's desired conclusion (i.e., the claims are identically disclosed by the prior art) is driving the Examiner's analysis of the prior art instead of having the Examiner's analysis of the prior art driving the Examiner's conclusion.

As identified by Appellants throughout the prosecution of the present Application, the Examiner's analysis fails to specifically identify many of the claimed elements relied upon by the Examiner in rejecting the claims. Moreover, although the Examiner has consistently "interpreted broadly"¹⁰ the language of the claim, the Examiner fails to (i) provide explicit claim constructions for the language at issue; (ii) explain why the Examiner's claim construction is both broad and *reasonable*; (iii) explain why the Examiner's claim construction is consistent with Appellants' specification and consistent with the meaning one having ordinary skill in the art would attribute to the language; and (iv) provide factual support for any of the Examiner's

⁸ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

⁹ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

¹⁰ See, e.g., last full paragraph on page 5 of the Seventh Office Action.

analysis. Instead, the Examiner's analysis consists of conclusory statements that the applied prior art teaches the limitation of the claims without substantive explanation.

Additionally, as will be described in more detail below, the Examiner does not simply just construe the language of the claim so as to assert that the applied prior art identically discloses these limitations, the Examiner actually admits, on multiple occasions, that the Examiner is not giving patentable weight to certain claim limitations. Instead, much of the Examiner's response to Appellants' arguments consist of complaining that the language of the claims are not explicitly defined in the specification. The Examiner, based upon this alleged lack of definitions, then proceeds to ignore the claim language at issue.

Claim 8

In responding to the Sixth Office Action dated June 6, 2007, Appellants amended the claims to clarify certain limitations in a Response dated September 6, 2007 (hereinafter the Response). Specifically, the claims were amended to replace "of a first type" and "of a second type," respectively, with "of a first filter expression format type" and "of a second filter expression format type." On page 7 of the Response, Appellants referred to the paragraph spanning pages 4 and 5 of Appellants' disclosure and asserted the following:

Thus, as described in Applicants' disclosure the different "types" refer to the format of the message relative to where a particular type of filter expression is located within the message. In this regard, Applicants note that the claims have been amended to clarify that the "first type" now refers to a "first filter expression format type." Thus, as claimed, the first type refers to the formatting of the filter expressions within the request. The claimed "second type" has been similarly amended, and refers to the formatting of the filter expressions within the publication message.

Thus, claim 8 now recites receiving both "a subscription request of a first filter expression format type" and "a publication message of a second filter expression format type"

and that "the first filter expression format type is different than the second filter expression format type."

With regard to receiving the subscription request and the publication message, the Examiner cited the same passages and made the same assertions in the Seventh Office Action as the Examiner made in the Sixth Office Action despite the language being amendment.¹¹ Thus, the Examiner's analysis in the statement of the rejection in the Seventh Office Action does not address the *different language* of the claims.

In the last full paragraph on page 4 of the Seventh Office Action, the Examiner specifically asserted the following regarding the newly added language to the claims:

In response the Examiner points out that the newly amended claim limitations have no limiting definition within the applicant's specification and are therefore interpreted broadly. There is no discussion of what a first filter expression format type comprises nor is there any discussion of what a second filter expression format type comprises. Therefore the profile and new article are considered to have some form of "filter expression format" and clearly the profile and the article taught by Herz are different.

The Examiner's analysis is very poorly reasoned.

Since the Examiner did not reject the newly added language under the second paragraph of 35 U.S.C. § 112, Appellants presume the Examiner believes the claim language is definite. However, the Examiner asserts that the limitations "have no limiting definition within the applicant's specification" and there is "no discussion of what a first filter expression format type comprises," and based upon this rationale, the Examiner asserts that the teachings of the applied prior art "are considered to have some form of 'filter expression format'."

¹¹ Compare third to last paragraph on page 9 of the Sixth Office Action with the penultimate full paragraph on page 7 of the Seventh Office Action, and compare last full paragraph on page 9 of the Sixth Office Action with the first full paragraph on page 8 of the Seventh Office Action.

After willfully failing to set forth a claim construction for the terms at issue and ignoring both Appellants' specification and Appellant's explanation, the Examiner presumes that these terms are undefined, and on this basis, the Examiner then presumes that the prior art teaches these limitations. The *coup de grâce* in the Examiner's (lack of) analysis is the Examiner's final assertion that "clearly the profile and the article taught by Herz are different." As readily apparent from the Examiner's analysis, the Examiner has not construed a definition for the claimed filter expression format type, yet the Examiner somehow is confident in asserting, without any factual support, that the filter expression format type of the profile of Herz is different from the filter expression format type of the article of Herz.

Notwithstanding that the Examiner has not established even the barest of a prima facie case of anticipation, and thus, the burden of showing patentability has not yet shifted to Appellants, Appellants will address some of the multitude of errors presented by the Examiner. Turning to the issue of the claim construction of the term "filter expression format type," the term "filter expression" is originally found within the claims. Thus, the filter expression format type refers to a type of format of the filter expression. As noted on page 5, lines 19-21, "[s]ubscriptions may arrive at the broker in a variety of different formats according to the messaging protocol used."

As also recited in claim 8, the first filter expression format type is different than the second filter expression format types. Thus, there are two different types of formats for filter

expressions, an example of which is illustrated in Fig. 3 of Appellants' disclosure, which was referred to in Appellants' discussion on page 7 of the Response.

Therefore, for the Examiner to assert that "the newly amended claim limitations have no limiting definition with the applicant's specification" evidences the Examiner's ignorance of the requirement that the Examiner is to establish a claim construction for the claimed limitations. Also, the Examiner's analysis reflects a failure to either consider Appellants' specification and/or read Appellant's comments in the Response in considering the meaning of the terms at issue.

As to the Examiner's assertion that "the profile and new article are considered to have some form of 'filter expression format'" is entirely without factual basis. The Examiner's cited passages regarding the claimed "receiving a subscription request ..." (i.e., column 4, line 49 through column 5, line 7; column 56, lines 21-25) and the claimed "receiving a publication message ..." (i.e., column 4, line 49 through column 4, line 22; column 57, lines 20-29) do not refer to specifics in a publication message or a subscription request. Instead, the first cited passage (i.e., column 4, line 49 through column 5, line 22) is a compilation of definitions and a teaching that refers to a "target profile." As argued throughout the prosecution of the present Application, a target profile is not comparable to a subscription request.

Referring to the cited passages in columns 56 and 57, both of these passages do not refer to the claimed "receiving a publication message." As such, Appellants are unclear as to how the Examiner can know (and assert) that the limitations associated with the content of the publication message are identically disclosed by Herz.

Column 57, lines 20-21 refer to "the user requests access to 'news' at step 102." *Assuming arguendo* that the Examiner is asserting that this request corresponds to the claimed "subscription request," the Examiner has failed to specifically indicate where Herz teaches that this request includes the other limitations associated with the claimed "receiving a subscription request."

Referring to the newly added claim language of the first filter expression format type is different than the second filter expression format type, the Examiner asserted that "clearly the profile and the article taught by Herz are different." (see also the fourth full paragraph on page 8 of the Seventh Office Action in which the Examiner asserts "the search profile is clearly different from the article"). The Examiner's "analysis" neglects to (i) explain how the search profile is different than the article and (ii) consider that the search profile (presumably corresponding to the subscription request) and the article (presumably corresponding to the publication message) must be similar in that both can be characterized as having a filter expression format type (albeit of different types).

The Examiner presumes that both the search profile and the article must necessarily (i.e., inherently) have a filter expression format type. However, the Examiner has not presented any factual support for this analysis. Moreover, notwithstanding that the article is "clearly" different than the search profile, as asserted by the Examiner, the fact that the article is different than the search profile does not necessarily (i.e., inherently) establish that the article and the search

profile have different filter expression format types. Yet again, the Examiner has not presented any factual support for this inherency argument.

Appellants incorporate herein the arguments previously presented in pages 3-12 of the Appeal Brief filed January 24, 2007. Referring to the Response, Appellants also presented the following arguments. On page 4 of the Sixth Office Action, the Examiner asserted the following:

However, claim 8 does not even recite keywords and target objects so the applicant's statement that claim 8 does recite such features is fallacious. Even if, for argument's sake, claim 8 did recite such limitations Herz teaches these features as shown in col. 56, lines 2 1-25. The mentioned attributes can be keywords and target objects. The keywords and target objects are considered the filter expressions.

The Examiner has mischaracterized Appellants' arguments. The basis of Appellants' arguments is the following: (i) the Examiner has relied upon "keywords and target objects," presumably, to teach the claimed "at least one attribute." Appellants' argument was directed to the fact that if the Examiner is to rely upon "keywords and target objects" then Herz has to teach that "the keywords and target objects" are found in a subscription request, since claim 8 recites that "the request includes a filter expression having a least one attribute." Appellants used the phrase "keywords and target objects" since these were terms used by the Examiner to allegedly disclose the claimed features. Thus, it is proper and not "fallacious" for Appellants, upon describing what Herz fails to teach, to refer to terms used by the Examiner.

In response to the above-presented arguments, which are found on pages 6 and 7 of the Response, the Examiner asserted the following in the paragraph spanning pages 3 and 4 of the Seventh Office Action:

The applicant first argues that Herz does not teach attributes in a subscription request on the paragraph spanning from pages 6-7. In response the Examiner [sic] points out that the applicant's specification provides no limiting definition of the "attributes" or a "subscription request" so the interpretation and explanation provided in the rejection is proper given the broad claim language used by the applicant. The applicant has not provided any explanation of what a subscription request is and how the request for publications of interest taught by Herz cannot be considered a subscription request.

Yet again, the Examiner does not provide a claim construction for the terms at issue or explain how the applied prior art identically discloses the limitations at issue. Instead, the Examiner relies upon the assertion that since the Examiner can broadly interpret the claim language however the Examiner sees fit, the end result is that the Examiner will interpret the claim language, no matter how unreasonably or factually unsupported, so as to read upon the teachings of the applied prior art.

The Examiner asserts that the "applicant has not provided any explanation of what a subscription request is and how the request for publications of interest taught by Herz cannot be considered a subscription request," yet the Examiner has not set forth a claim construction for the term "subscription request" and explained why the Examiner believes that the applied prior art teaches the claimed limitations. Yet again, the Examiner attempts to improperly shift the burden to Appellants to explain why the claims are patentable over the applied prior art without explaining, with any specificity, why the Examiner believes the claimed are identically disclosed.

As to the Examiner's requested "explanation," the claimed language, as a whole, associated with the "subscription request" indicates that the data needed to perform the filtering is included within the request. On the contrary, the Examiner has not established that the search profile P_k disclosed by Herz is included with the user request (see column 57, lines 20-24).

Instead, Herz describes many methods for generating the search profile in column 56, lines 14-28, but none of the methods include have the search profile included within the user request (i.e., presumably corresponding to the claimed subscription request).

In the paragraph spanning pages 4 and 5 of the Sixth Office Action, the Examiner asserted the following:

However, this argument completely ignores the description (or lack there of) of a "first type" given by the applicant's specification. The only description the applicant's specification gives for types is that a subscription request is of type "A" and a publication is of type "B" (See page 18 of applicant's specification). There is no limiting definition of what a "type" comprises. Therefore the Examiner's interpretation that the "search profile" is of a "first type" and the "target profile" is of a "second type" is consistent with the applicant's broad disclosure.

Appellants respectfully submit that the Examiner has not considered the entirety of Appellants' disclosure. In this regard, the Examiner is referred to the paragraph spanning pages 5 and 6 of Appellants' disclosure and reproduced below:

FIG. 3 shows two example message formats A and B. It can be seen that message A has two headers (HDR1; HDR2) and a main body, whilst message B has three headers (JHDR1; JHDR2; JHDR3) and a body. In messages of type A the attribute, X (i.e Salary), sits in the second header. In messages of type B this same attribute sits in the third header. Thus it will be appreciated that the attribute itself typically has a common description, but its location may vary between message formats. The position of the attribute is typically used as a naming protocol for the identifier node. Thus it can be seen from FIG. 2 that the subscription request is of message type A since identifier node 110 has the name HDR1.HDR2.Salary showing that the attribute Salary sits in the second header.

Thus, as described in Appellants' disclosure the different "types" refer to the format of the message relative to where a particular type of filter expression is located within the message. In this regard, Appellants note that the claims have been amended to clarify that the "first type" now refers to a "first filter expression format type." Thus, as claimed, the first type refers to the formatting of the filter expressions within the request. The claimed "second type" has been

similarly amended, and refers to the formatting of the filter expressions within the publication message.

In response to the above-presented arguments, which are found on page 7 of the Response, the Examiner asserted the following in the first full paragraph on page 4 of the Seventh Office Action:

Next the applicant argues that "the Examiner has not considered the entirety of Applicants' disclosure" and cites the paragraph spanning pages 5 and 6 of the applicant's disclosure. In response, the Examiner sees nothing more than an incomplete example at best provided by this paragraph. The paragraph in question does nothing to limit the terms "first filter expression type" nor has the applicant provided any explanation of how the paragraph does provide support.

This passage is another example of the Examiner's non-responsive "response" to Appellants' arguments. The Examiner again does not set forth a claim construction or explain why the applied prior art teaches the limitations at issue. Instead, the Examiner simply asserts that language of the claims are not limited and essentially fails to give them any patentable weight.

In the first full paragraph on page 5 of the Sixth Office Action, the Examiner asserted the following:

The applicant goes on to allege that the Examiner must be relying on inherency. The Examiner, however, had made it clear how Herz reads on all of the applicant's claimed elements in the last office action and thus explicitly teaches the claimed invention. The applicant alleges that "a subscriber in Herz could submit a subscription request that is completely separate from the search parameters that are used." In response to this statement, the Examiner points out that the applicant provides no example from Herz that supports this conclusion and that the applicant's claims have nothing to do with a user anyway.

In response, Appellants note that the Examiner has still failed to establish that Herz explicitly teaches all of the limitations of the claimed invention. Much of the Examiner's analysis relies on unstated claim constructions and unstated analysis to which Appellants are not privy. Moreover,

as to Appellants' example as to why Herz does not identically disclose a particular feature, Appellants note that this example is not required of Appellants. Instead, the initial burden of establishing inherency rests with the Examiner. Thus, Appellants are not required to provide any factual support unless and until the Examiner factually supports the Examiner's inherency arguments.

In response to the above-presented arguments, which are found on page 8 of the Response, the Examiner asserted the following in the second full paragraph on page 4 of the Seventh Office Action:

On page 8 of the applicant's response the applicants note, " that the Examiner has still failed to establish that Herz explicitly teach all of the claimed invention. Much of the Examiner's analysis relies on unstated claim construction and unstated analysis to which the Applicant's are not privy". In response to this statement, the Examiner points out that the rejections provide explicit mappings about how the Examiner is interpreting every limitation and if the applicant had trouble understanding this interpretation, the applicant could have called the Examiner at the number indicated in each Office Action mailed in this application. In fact the Examiner invited the applicant to call the Examiner if the applicant wanted the rejections explained in the Office action mailed on 8/23/2006. No such call was ever made to the Examiner.

Notwithstanding the Examiner's invitation to 'explain' the Examiner's rejections, the policy of the Patent Office is that all business is to be transacted in writing. Moreover, the "examiner's action will be complete as to all matters." 37 C.F.R. § 1.104(b). If the Examiner's rejection requires explanation, as in the present Application, then the Examiner's Office Action has not met the requirements set forth in both sections (b) and (c)(2) of 37 C.F.R. § 1.104. Moreover, Appellants should not have to wait until have six (6) Office Actions have been issued, based upon the same reference and rejection, before the Examiner provides an explanation as to the imposed rejection, either written or orally.

Although Appellants believe that the amendments to the claims in the Response were not necessary to overcome the applied prior art, Appellants amended these claims so as to more clearly indicate the patentable features over the applied prior art based upon the Examiner's continued intransigence. However, despite these amendments and accompanying explanations, the Examiner ignored both. As such, where the Examiner ignores Appellants' amendments and explanation, and where the Examiner's analysis evidences confusion over very basic terms in the art (e.g., temporary storage), the Examiner's offer of a further explanation is specious.

In the paragraph spanning pages 5 and 6 of the Sixth Office Action, the Examiner asserted the following:

In response the Examiner points out that the applicant does not describe the claimed (i) generic format; (ii) that at least one attribute; and (iii) the mapping (See page 18 of the applicant's specification). Given that the applicant's specification provides no limiting definition for these terms, the reasoning previously supplied in the Final Rejection is all that can be expected of the Examiner. Specifically the Final Rejection stated that in Herz col. 57, lines 39-51, the search profiles are mapped to generic cluster profiles. As previously discussed the search profiles contain keywords and target objects, considered attributes.

Under 35 U.S.C. § 102, the applied prior art must identically disclose each limitation of the claimed invention. Generic cluster profiles are not a generic format. The term "format" has a readily discernable meaning and although a profile may have a format, a profile is not the same as a format. Also, "profiles [being] mapped to generic cluster profiles" does not identically disclose "mapping the generic format filter attribute to a format." Notwithstanding the Examiner's assertion that a profile includes attributes, the mapping of a profile is not necessarily comparable to the mapping of an attribute.

In response to the above-presented arguments, which are found in the paragraph spanning pages 8 and 9 of the Response, the Examiner asserted the following in the last full paragraph on page 5 of the Seventh Office Action:

On page 9 of the applicant's remarks the applicant argues that, "Notwithstanding the Examiner's assertion that a profile includes attributes, the mapping of a profile is not necessarily comparable to the mapping of an attribute." The applicant provides no further explanation so the Examiner maintains the position in question because the rejection would not have been set forth if it was believed by the Examiner that Herz reads on the limitations in question. (emphasis added)

Referring to the above-underlined passage and notwithstanding that the Examiner likely intended to use the phrase "did not read on the ..." instead of "reads on the ...", the Examiner's arguments is essentially, "I would not have rejected the claim if I did not believe the claim should have been rejected," which is circular logic at its very worse. Thus, by the Examiner's logic, the Board should uphold all rejections made by Examiners since a rejection would not have been made if the rejection was not proper.

Notwithstanding the Examiner's hubris, the Examiner, yet again, forgets that the burden of establishing a prima facie case of evidence rests with the Examiner. To borrow a phrase from the Examiner, the mapping of a profile appears to be "clearly different" than the mapping of an attribute. Thus, the Examiner is burdened with explaining why the Examiner believes the Examiner's analysis is proper. This burden, however, has not been met.

On page 7 of the Sixth Office Action, the Examiner asserted the following:

With respect to the dependent claims, the applicant alleges that the claim limitations are generally not taught without an elaboration. The explicit mapping of provided in the rejections of these claims shows how the claims are being interpreted. The rejection would not have been set forth if it was not believed that Herz taught the claim limitations.

Appellants do not doubt the Examiner has a reason for rejecting the dependent claims. However, the Examiner has not fully shared these reasons with Appellants. What has been provided by the Examiner are incomplete findings of fact without analysis and without claim constructions. Appellants are not in a position to guess/speculate as to the reasons why an Examiner is rejecting a particular claim or as to the claim construction that the Examiner is employing to reject a particular claim.

As noted by the Supreme Court in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,¹² a clear and complete prosecution file record is important in that "[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process." The Courts that are in a position to review the rejections set forth by the Examiner (i.e., the Board of Patent Appeals and Interferences, the Federal Circuit, and the Supreme Court) can only review what has been written in the record; and therefore, the Examiner must clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner in the statement of the rejection.

Claims 11-14

With regard to these limitations, the Examiner merely cites column 56, line 49 through column 57, line 5 or asserts "the [target/search] profiles are analyzed as described above." This "analysis" by the Examiner again fails to clearly identify the specific elements within Herz being relied upon in the rejection.

¹² 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

The Examiner did not directly address this argument in the Fifth Office Action or the Sixth Office Action. The Examiner, however, generically addressed these arguments in the thirteenth enumerated paragraph on page 5 of the Fifth Office Action, in which the Examiner asserted the following:

13. The applicant further argues that the examiner has not clearly shown the rest of the claim limitations, however, the examiner feels that the rejection based on Herz clearly shows how Herz anticipates the claim language. If the applicant is still having trouble understanding the current rejections, the examiner invites the applicant to call the examiner so that the examiner can explain the rejections to the applicant. At that point the applicant can decide whether to make an amendment or how to argue that the limitations of the claims with respect to the applicant's invention are different from Herz.

The Examiner has rejected the claims under 35 U.S.C. 102 for anticipation based upon Herz since the first Office Action dated March 1, 2005. In each of the Appellants' responses to the first four Office Actions, Appellants have argued that the Examiner has failed to establish that Herz identically discloses the claimed invention. The Examiner, however, has continually failed to specifically address Appellants' arguments. Moreover, the above-reproduced paragraph is essentially a blanket disagreement with the extensive arguments presented above with regards to claims 8, 10, and 11-14 without a clear explanation as to why the Examiner disagrees.

The Examiner also indirectly addressed all of Appellants' arguments as to the dependent claims in the first full paragraph on page 5 of the Examiner's Answer in which the Examiner asserted the following:

With respect to the dependent claims the applicant is again arguing that the Examiner has not fully shared the reasons for rejecting the claims. The Examiner disagrees because the Examiner feels that the claims are explicitly mapped and again points out that the applicant never called for clarification but instead chose to complain that the, "Applicants are not in position to guess/speculate as to the reasons why an Examiner is rejecting a particular claim or as to the claim construction that the Examiner is employing to reject a particular claim." The Examiner has established a prima facie case of anticipation and the Examiner is not responsible for the applicant's representatives seeming inability to comprehend the rejections presented.

To be clear, the Examiner's alleged "explicitly mapped" claims include the following analysis on pages 8 and 9 of the Seventh Office Action:

Claim 11: citing column 57, lines 8-51, while generically asserting "the search profile are analyzed as described above";

Claim 12: citing column 56, line 49 through column 57, line 5 without explanation;

Claim 13: not citing any passages while generically asserting "the target profiles are analyzed as described above"; and

Claim 14: citing column 56, line 49 through column 57, line 5 without explanation.

Notably absent from the Examiner's "analysis" (i.e., beyond the Examiner reproducing the language of the claims, word-for-word) is any reference to the actual language of the claims. Based upon the Examiner's stated analysis throughout the Seventh Office Action, the Examiner appears to be of the belief that if the Examiner is "sure" of the rejection, since the Examiner would not reject the claims without the claims being rejectable, then the Examiner is not obligated to explain the Examiner's rationale beyond citing long passage within the prior art and accompanying these citations with minimal analysis.

Appellants' position is that the Examiner has confused the concepts of making a rejection with explaining the rejection. Specifically, the Examiner believes that making a rejection is all that is required and that an explanation of the rejection need only be performed upon Appellants making an explicit request for an interview for said explanation. However, as evidenced by the ample case law presented by Appellants throughout the prosecution of this application and the Patent's Office's own rules, the Examiner's analysis is deficient in many respects and fails to set forth a prima facie case of anticipation as to the claims.

**THE REJECTION OF CLAIMS 8-14 UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED
UPON JANNU**

For convenience of the Honorable Board in addressing the rejections, claims 11-14 stand or fall together with independent claim 8.

With regard to claim 8, the Examiner asserted the following on page 11 of the Sixth Office Action:

As to claim 8, Jannu teaches a method for receiving publications and forwarding said publication on to parties who have subscribed to receive such publications, said method comprising: receiving a subscription request (col. 6, lines 9-11) of a first type (col. 6, lines 6-9, **the "first" type could be a mainframe, CORBA, or JMS message**), said request including a filter expression having at least one attribute (col. 6, lines 16-22, **the information which registers the interest is considered the filter expression with an attribute**); receiving a publication message (col. 6, line 18) of a second type (col. 6, lines 6-9, the **"second" type could be a mainframe, CORBA, or JMS message**); comparing the publication message received to the subscription request to determine whether the publication message is appropriate for forwarding onto a subscriber originating the request (col. 6, lines 16-22), the step of comparing comprising: identifying a generic format filter attribute (col. 6, lines 58-64, **the structured event format**); and mapping the generic format filter attribute to a format corresponding to the second message type (col. 6, lines 58-64), the method further comprising: transmitting said publication message to the originating subscriber (col. 6, lines 21-22). (emphasis in original)

Claim 8 recites, in part, "mapping at least part of the at least one attribute to a generic format." However, upon reviewing the Examiner's statement of the rejection, the Examiner has not even alleged that Jannu teaches this particular limitation. Thus, on this basis alone, the Examiner has failed to establish a prima facie case of anticipation.

Moreover, as previously noted, the claims have been amended to clarify that the first type is first filter expression format type and the second type is a second filter expression format type and that the first filter expression format type is different than the second filter expression format type. As previously noted above, the type refers to the formatting of the filter expressions within the request or publication message. The Examiner's cited reference of Jannu, however, is silent

as to the formatting of filter expressions within the alleged request (i.e., list of subscribers and the types of messages they have registered to receive) and the alleged publication message (i.e., message sent by publisher). Thus, for the reasons stated above, Appellants submit that the imposed rejection of claims 8-14 under 35 U.S.C. § 102 for anticipation based upon Jannu is not factually viable.

In response to the above-presented arguments, which are on pages 11 and 12 of the Response, the Examiner asserted the following in the last full paragraph on page 6 of the Seventh Office Action:

First the applicant argues that the Examiner has not even alleged that Jannu teaches the limitation of "mapping at least a part of the at least one attribute to a generic format". The Examiner disagrees. It would be apparent to anyone reading the disclosure provided by Jannu that subscription messages are received in multiple formats (mainframe, JMS, CORBA etc.). The various formats are mapped to a structured event as explained in the cited portion of Jannu (col. 6, lines 58-64). The mapping makes it clear that this is how the claim is interpreted and thus a prima facie case of anticipation was established.

The applicant then argues that Jannu does not teach the amended first filter expression format type and the second filter expression format filter type. Given the non-limiting definitions provided by the applicant of these terms, the subscribe and publish messages taught by Jannu read on these limitations. (emphasis added)

The Examiner's disagreement to the contrary, the Examiner did not allege that Jannu taught the step of "mapping ..." in the Sixth Office Action.

The Examiner's newly cited passage of column 6, lines 58-64 of Jannu is reproduced below:

The addition of the abstraction layer of the message brokering server 360 allows all adapters 340 and 350 to remain unchanged. The adapters 340 and 350 merely need to convert from a native data format into a structured event. The message brokering server 360 then handles the conversion from the structured event into the proprietary data format of the publish/subscribe engine 370.

Since the Examiner, yet again, has failed to clearly identify the specific features being relied upon in Jannu to teach the specific claimed limitations, Appellants can only guess as to the Examiner's analysis. Notwithstanding the ambiguities in the Examiner's analysis, the claim language at issue is

"mapping the generic format filter attribute to a format corresponding to the second filter expression format type," with the second filter expression format type being associated with the received publication message. However, notably absent from the Examiner's cited passage is a discussion of the received publication message or the second filter expression format type.

As to the underlined passage of the above-reproduced citation, the Examiner is improperly failing to give any patentable weight to the newly added language of the claims, and on this basis, the Examiner is improperly concluding, without factual support, that Jannu identically discloses these limitations. Thus, the Examiner's analysis is not based upon establishing that Jannu identically discloses these limitations. Instead, the Examiner's analysis based upon the belief that once the Examiner asserts (without legal basis) that the limitations are "non-limiting," then the Examiner is not required to establish that the prior art identically discloses these limitations. Appellants' position, for reasons previously discussed, is that such an analysis constitutes legal error.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections under 35 U.S.C. § 102 based upon the applied prior art is not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 102.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: September 29, 2008

Respectfully submitted,

/Scott D. Paul/

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VIII. CLAIMS APPENDIX

8. A method for receiving publications and forwarding said publications on to parties who have subscribed to receive such publications, said method comprising:

receiving a subscription request of a first filter expression format type, said request including a filter expression having at least one attribute;

mapping at least part of the at least one attribute to a generic format;

receiving a publication message of a second filter expression format type;

comparing the publication message received to the subscription request to determine whether to forward the publication message to a subscriber originating the request, the comparing comprising:

identifying a generic format filter attribute; and

mapping the generic format filter attribute to a format corresponding to the second filter expression format type, the method further comprising:
transmitting said publication message to the originating subscriber, wherein
the first filter expression format type is different than the second filter expression format type.

9. The method of claim 8, further comprising:

preparing the publication message for transmission to said originating subscriber.

10. The method of claim 9, wherein the preparing the publication message for transmission to said originating subscriber comprises:

creating a substantially empty message of said first filter expression format type;
extracting information from the publication message of said second filter expression format type; and
inputting said information into said substantially empty message.

11. The method of claim 8, 9 or 10, wherein the mapping at least part of an attribute to a generic format comprises:

invoking a first component capable of understanding messages of said first filter expression format type.

12. The method of claim 8, 9 or 10, comprising:

storing said generic format filter attribute.

13. The method of any of claims 8, 9 or 10, wherein the mapping a generic format filter attribute to a format corresponding to the second filter expression format type comprises:

invoking a second component capable of understanding messages of said second filter expression format type.

14. The method of any of claims 8, 9 or 10, wherein said format corresponding to the second message type is held in temporary storage until said comparison is complete.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.